



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,079	10/21/2005	Martin Kurth	16-885 P/US	4484
26294 7590 03/24/2008 TAROLLI, SUNDHEIM, COVELL & TUMMINO L.L.P. 1300 EAST NINTH STREET, SUITE 1700 CLEVEVLAND, OH 44114				
EXAMINER				
MACARTHUR, VICTOR L				
ART UNIT		PAPER NUMBER		
3679				
MAIL DATE		DELIVERY MODE		
03/24/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/554,079

Applicant(s)

KURTH ET AL.

Examiner

VICTOR MACARTHUR

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☐ Claim(s) _____ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 04 February 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 8/23/2007
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Drawings

Drawings

The drawings were received on 12/4/2008. These drawings are acceptable for the purposes of examination.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "base" (line 2 of claim 7), "at least one engagement element [of the inner sleeve]" (lines 11-12 of claim 7); the "at least one engagement element on the outer sleeve" (lines 12-13 of claim 7); and the "plurality of engagement elements" (two separate recitations in lines 2-4 of claim 8) must be shown with a reference character that is described in the specification or the features canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Abstract/Specification

The examiner notes that applicant's remarks filed 8/23/2007 state that a new abstract has been submitted. However, any amendment to the abstract must be done on a separate sheet from any amendment from the specification. Accordingly the amendment to the Specification and Abstract filed 8/23/2007 is technically non-compliant with 37 CFR 1.121 and more particularly with 37 CFR 1.72. Applicant must submit amendments to the Specification and Abstract on separate sheets in any response to this Office Action to avoid a holding of non-compliance.

The Specification and Abstract remain objected to for the reasons detailed in the previous Office Action mailed 5/21/2007 since the amendment thereto filed 8/23/2007 was not done on separate sheets.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear how the limitation “configured in accordance with the second connecting unit” (line 2 of claim 13) is meant to structurally limit the claim. The word “accordance” is taken by the examiner to mean “agreement or conformity with a rule” as recited in Merriam-Webster’s Collegiate Dictionary Tenth Edition. How is the “second connecting unit” a rule? If the applicant means to claim that the first connecting unit is configured to be structurally identical to the second connecting unit then the claims must be amended accordingly. However, the examiner notes that the first and second connecting units as shown in the drawings do not appear to be identical.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krause (U.S. Patent 6,264,393).

Claim 7. Krause discloses (fig.4) a device comprising: a base (door or wall of vehicle described in col.1, ll.5-15) having a carrier part (2); a first connecting unit (3) comprising a sleeve (17) connected to the carrier part. Krause does not expressly state that there is more than one connecting unit.

- However, one of ordinary skill would easily recognize that duplicating the Krause first connecting unit such that there is a second connecting unit would necessarily increase the

connection force and thus improve the connection strength. It has generally been recognized that duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Furthermore, the applicant has failed to demonstrate criticality by any showing of unexpected result derived from multiple connecting units over a single connecting unit. Wherein a specific limitation has no criticality, case law can be relied upon as the sole rationale in an obviousness rejection. See MPEP 2144.04. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to duplicate the prior art first connecting unit such that there is a second connection unit, for the purpose of increasing connection force and improving the connection strength, and further since the limitation has no criticality and has thus been established by the case law cited above to be an obvious design consideration within the skill of the art. “[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8.” In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).

- Such modification would necessarily result in the prior art device further comprising: a second connecting unit (second unit similar to first shown in figure 4) comprising a guide part (second 17) connected to the carrier part and a holding part (second 10) releasably engageable with the guide part; wherein the guide part includes an outer sleeve (second 17) that defines a guide cavity (cavity within second 17) for receiving the holding part, the guide cavity having a cross section that is longer in the longitudinal direction than in

the transverse direction; wherein the holding part includes an inner sleeve (second 10) having a smaller diameter than the diameter of the outer sleeve, the inner sleeve including at least one engagement element (engagement elements of second 10 engaging with second 17) that engages at least one engagement element (engagement elements of second 17 engaging with second 10) on the outer sleeve. Furthermore, in accordance with MPEP 2112.01, the prior art structure is presumed to be inherently capable of performing the following functional/intended-use limitations:

- for fastening cable (line 1 of claim 7).
- for holding the cable (line 2 of claim 7).
- to fasten the cable to the carrier part (last line of claim 7).

Claim 8. Krause suggests the device of claim 7 wherein the at least one engagement element on the inner sleeve comprises a plurality of engagement elements and the at least one engagement element on the outer sleeve comprises a plurality of engagement elements.

Claim 9. Krause suggests the device of claim 8 wherein the engagement elements on the outer sleeve are formed by guide recesses that extend in the longitudinal direction and the engagement elements on the inner sleeve are formed by guide projections that extend in the longitudinal direction.

Claim 10. Krause suggests the device of claim 9 wherein the guide projections are configured on walls of the guide part and the guide recesses are configured on walls of the holding part.

Claim 11. Krause suggests the device of claim 10 wherein the guide projections exhibit a substantially (but not completely) triangular cross section, whereby the leading edge of the projection is more steeply angled than the trailing edge of the projection during engagement with the inner sleeve.

- It has generally been recognized that a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Furthermore, the applicant has failed to demonstrate criticality by any showing of unexpected result derived from completely triangular cross sectional shape over a substantially triangular cross sectional shape. Wherein a specific limitation has no criticality, case law can be relied upon as the sole rationale in an obviousness rejection. See MPEP 2144.04. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the substantially triangular prior art shape to be completely triangular in shape, since the limitation has no criticality and has thus been established by the case law cited above to be an obvious design consideration within the skill of the art. “[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8.” In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).

Claim 12. Krause suggests the device of claim 7 wherein the holding part surrounds a continuous holding channel (holding channel within second 10) and is configured with inward pointing latching lugs (lugs at top of second 10).

Claim 13. Krause suggests the device of claim 7 wherein the first connecting unit is configured in accordance with the second connecting unit, and exhibits a displaceable holding part (first 10), whereby the longitudinal direction of the holding part of the first connecting unit is parallel to the longitudinal direction of the holding part of the second connecting unit (as would be necessary from their mutual mounting on element 2).

Claim 14. Krause suggests the device of claim 7. In accordance with MPEP 2112.01 it is presumed that the prior art structure is inherently capable of performing the functional limitation “wherein the holding part and guide part cooperate to adapt to positional and dimensional errors in the second connecting unit”. Regarding inherency of functional limitations, see MPEP 2112.01 (I). See also *Ex parte Martin et al*, decision of the Board of Patent Appeals and Interferences, Patent No. 6920019, the paper filed on 11/19/2004, pages 6 and 9. Note that citation of an unpublished decision of Board of Patent Appeals and Interferences is proper when it is available to the public in the patented file, in accordance with MPEP §707.06.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 3679

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

March 28, 2008

/Victor MacArthur/
Primary Examiner, Art Unit 3679